

PATENT
ATTORNEY DOCKET NUMBER: 00786/540002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Gardella et al.	Confirmation No.:	1482
Serial No.:	10/564,744	Art Unit:	1654
371(c) Date:	March 3, 2006	Examiner:	Gupta, Anish
Patent No.	7,910,544	Customer No.:	21559
Issued:	March 22, 2011		
Title:	CONFORMATIONALLY CONSTRAINED PARATHYROID HORMONE (PTH) ANALOGS		

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Patentees note that the patent term adjustment set forth in the above-referenced patent appears to be shorter than appropriate.

Patentees submit that the Applicant delay was improperly calculated in view of the Request to Correct Inventorship that was filed September 15, 2010 ("the Request"). This is explained in detail below.

Applicant delay

The Office calculated a total Applicant delay of 283 days¹. In arriving at this calculation, the Office calculated six periods² of delay:

1. A period of 61 days for filing a response on July 6, 2009 to an Office action mailed February 6, 2009,

¹The PTO records available on the PAIR system indicate 373 days of Applicant delay. However, in the Petition Decision dated February 11, 2010, the Office indicated that a net of 90 days of Applicant Delay would be removed. This is now reflected as a "manual adjustment" of the PTA calculation on PAIR. Because the difference between the manual adjustment and the 373 days noted in the PTO records is 283 days, the Applicant delay is therefore 283 days.

²Applicants have not included the 92 days of reduction indicated on the PAIR system for the Information Disclosure Statement filed June 22, 2010, because the Office indicated in the February 11, 2011 Petition Decision that this delay was applied in error and because this delay has been offset in the PTO records on the PAIR system as an "Adjustment of PTA Calculation by PTO."

2. A period of 14 days for submission of an Information Disclosure Statement (IDS) on July 20, 2009 following a reply filed July 6, 2009,
3. A period of 25 days for filing a response on March 22, 2010 to an Office action mailed November 25, 2009,
4. A period of 2 days³ for submission of an IDS on March 24, 2010 following a reply filed March 22, 2010.
5. A period of 61 days for submission of the Request filed on September 15, 2010.
6. A period of 120 days for submission of an Application Data Sheet on November 15, 2010, in response to a communication dated October 19, 2010.

Patentees are not disputing the calculation of items numbered 1-4 and 6 above. Patentees, however, believe that the 61-day period set forth under item 5 above is improperly calculated.

The reduction of PTA for a period of 61 days for filing of the Request on September 15, 2010, should instead be a period of 20 days. 37 C.F.R. §1.704(c)(10) states (emphasis added):

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months

The Office provided a Notice dated October 5, 2010 in which the Request was granted. This Notice clearly constitutes a “response to the amendment under § 1.312 or other paper,” as set forth under 37 C.F.R. § 1.704(c)(10). Accordingly, the proper adjustment

³This two-day period of delay is reflected on the PAIR system as “Adjustment of PTA Calculation by the PTO.” Based on the Petition Decision dated February 11, 2011, Patentees conclude that this period for delay reflects the IDS filed March 24, 2010.

for the period of delay associated with the Request should begin on September 15, 2010 and end on October 5, 2010, a period of 20 days.

Office delay

Patentees do not dispute the calculation of 1213 days of non-overlapping Office delay.

Total patent term adjustment

Patentees conclude that the Office delay associated with the above-captioned patent is 1213 days, while the Applicant delay is $61+14+25+2+20+120$ days, a total of 242 days. Thus, the present application is entitled to a total of $1213 - 242 = 971$ days of patent term adjustment under 37 C.F.R. § 1.703. Patentees request that the Office issue a Certificate of Correction reflecting the correct patent term adjustment determination.

CONCLUSION

Patentees respectfully request that the Office correct patent term adjustment as explained above. Transmitted herewith is \$200.00 in payment of the fee set forth in 37 C.F.R. § 1.18(e). If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 19 May 2011



Karen L. Elbing, Ph.D.
Reg. No. 35,238

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110
Telephone: 617-428-0200
Facsimile: 617-428-7045